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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY K. JONES

Appeal 2009-000893
Application 10/622,790
Technology Center 1700

Decided: December 17, 2009

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner rejecting for at least the second time claims 1-18, 26, and 27 in the Office Action mailed November 2, 2006. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

We reverse the decision of the Primary Examiner.

Claim 1 illustrates Appellants' invention of a breathable material, and is representative of the claims on appeal:

1. A breathable material, comprising a low-elongation fabric layer exhibiting less than about 30% elongation as measured according to ASTM D5034 in at least one direction, and a microporous coating thereon, the microporous coating comprising a crystalline polymer composition and a filler.

The Examiner relies upon the evidence in these references (Ans. 3):

Sheth	4,929,303	May 29, 1990
Gardner	US 2002/0071944 A1	Jun. 13, 2002
Carroll	US 2004/0023585 A1	Feb. 5, 2004

Appellant requests review of the ground of rejection under 35 U.S.C. § 103(a) advanced on appeal by the Examiner: claims 1-18, 26, and 27 over Gardner in view of Carroll or Sheth. App. Br. 4; Ans. 3.

Opinion

In the Briefs, Appellant relies on arguments as well as on the evidence in Specification Example 1. *See generally* App. Br. and Reply Br. *See, e.g., In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("'On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.'") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Indeed, Appellant argues that the evidence in Specification Example 1 demonstrates that the claimed breathable material has unexpected benefits over the combined teachings of Gardner, Carroll, and Sheth. App. Br. 16; Reply Br. 6.

The Examiner has not addressed the evidence in Specification Example 1 in considering Appellant's position. *See generally* Ans. Thus, the Examiner has not based the conclusion of unpatentability set forth in the

Answer on the totality of the record. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.") (citing, *inter alia*, *In re Spada*, 911 F.2d 705, 707 n.3 (Fed. Cir. 1990)); *see also, e.g.*, *In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007), and cases cited therein (applicant's rebuttal evidence must be considered). Indeed, the Examiner's failure to consider the evidence in Specification Example 1, properly relied on by Appellant, is clear error. *See, e.g.*, *Sullivan*, 498 F.3d at 1355.

Accordingly, on this record, the Examiner has not rebutted Appellants' evidence of nonobviousness, and thus, we reverse the ground of rejection advanced on appeal.

The Primary Examiner's decision is reversed.

REVERSED

PL Initial:
sld

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